

REMARKS

Claims 1-20 and 22-42 have been examined and rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,594,640 to Postrel (hereinafter “Postrel”) in view of U.S. Patent No. 6,484,147 to Brizendine et al. (hereinafter “Brizendine”) and further in view of U.S. Patent Application Publication No. 2002/0007335 to Millard et al. (hereinafter “Millard”). Applicants respectfully traverse the rejection.

For example, claim 1 recites a method of exchanging trading points including a transaction processor that receives a request from a first customer to exchange trading points awarded to the first customer from a first member shop for trading points awarded to at least one other customer from a different member shop.

Postrel teaches a system of trading and redeeming points accumulated in frequent use reward programs. This system includes a trading server 20 which receives a request from a user to redeem accumulated reward points for goods or services provided by the issuer of the reward points. The system also allows users to purchase points traded by other users, such that points are redistributed without incurring a transaction directly with the issuing entity. Thus, the system enables the sale or repurchase of points with a trading strategy in which points need not expire.

The Examiner contends that Postrel’s trading server 20 corresponds to the claimed transaction processor. However, the Examiner admits that Postrel does not teach or suggest that the alleged request to exchange points is for trading points awarded to at least one other customer from a second member shop and cites Brizendine to cure this deficiency.

Brizendine is directed to a data processing system in which a first member 120 of a club 110 can purchase merchandise from a merchant 140 either in-store or on-line using a credit card

134. As a result a number of educational and merchant points are credited to an account of the first member 120. The first member 120 may also load points from his account to an account of a second member 130 in the club 110 who is able to redeem the points using a club card 124. The merchant points may be redeemed at various merchant stores, and the educational points may be redeemed at an educational facility such as a college or a university. The first member 120 may be a parent who loads points to his child's (second member 130) account. In this way, the child may redeem the points using a club card 124 rather than a credit card which children are not permitted to use.

The Examiner asserts that the combination of Postrel's trading strategy and Brizedine's transferring of merchant points suggests the claimed request from a first customer to exchange trading points awarded to the first customer from a first member shop for trading points awarded to at least one other customer from a different member shop. The Examiner further asserts that one of ordinary skill in the art would have been motivated to combine the references in order to allow a plurality of users to transfer trading points between each other.

However, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Postrel discloses throughout the reference, including the section cited by the Examiner, that a request is made by a user to *redeem rewards, goods, or services* (see at least col. 6, lines 13-16, lines 22-23, col. 8, lines 52-54, lines 65-67). The Examiner also cites column 5, line 59 to column 6, line 19 of Postrel to contend that Postrel's trading system and Brizendine's transferring of points suggests the claimed request to exchange trading points. However, the cited section discloses that Postrel's trading system enables points to continually be *sold and*

repurchased. Thus, Postrel teaches exchanging trading points for money or goods. While Brizendine discloses the transfer of points from a first member 120 to a second member 130, the Examiner seems to disregard Brizendine's disclosure that, in contrast to Postrel, the first member 120 *does not receive anything from the second member 130 in return* (col. 11, lines 13-35 of Brizendine). However, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Brizendine's feature of allowing a first member 120 to transfer points to a second member 130 without receiving anything in return clearly teaches away from Postrel's feature exchanging of trading points for money or goods. Thus, Applicants respectfully submit that the combination of Postrel and Brizendine as asserted by the Examiner is improper and does not render claim 1 unpatentable.

Claims 4, 10, 18, 28, 39, and 40 recite features that are analogous to those discussed above in conjunction with claim 1. Thus, Applicants submit that these claims are patentable at least for analogous reasons. Applicants also submit that claims 2, 3, 5-9, 11-17, 19, 20, 22-27, 29-38, 41, and 42, being dependent on one of claims 1, 4, 10, 18, 28, 39, and 40, are patentable at least by virtue of their dependency.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. §1.116
U.S. Application No. 09/751,391

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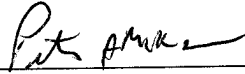
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